REMARKS

Claims 1, 18, and 33 have been amended and claims 2-17, 19-32, and 34-41 have been cancelled. Claims 42-52 have been added. No new matter has been added. Claims 1, 18, 33, and 42-52 are pending.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Interview Summary

An interview between Examiner Brian J. Livedalen and attorney Mark Goldstein was held on September 15, 2006. The patentability of claims 1 and 33 was discussed without reaching any conclusion.

Claim Objections

The Office Action objected to claims 12 and 37. Both claims have been canceled.

Claim Rejections - 35 USC § 102

The Office Action rejected claims 1-15, 17-30, 32-37, 40 and 41 under 35 USC § 102(e) as anticipated by Cardot (USP 6,831,761). Claim 1 has been amended to incorporate the limitations of claim 16 and selected limitations from intervening claims. Claim 18 has been amended to incorporate the limitations of claim 31 and selected limitations of intervening claims. Claim 33 has been amended to incorporate the limitations of claim 38 and selected limitations of intervening claims. Claims 1, 18, and 33 have been reworded for clarity. The other claims rejected under 35 USC § 102(e) have been canceled.

Amended claims 1, 18, and 33 contain limitations "first, second, and third enhanced color images signals having improved gradation..." and "the monochrome output signal has higher

gradation than the first, second, and third color output signals". The Office Action "recognizes that Cardot is silent regarding improving gradation". Thus Cardot cannot be shown to anticipate the limitations of claims 1, 18, and 33. Thus it is respectfully requested that the rejection under 35 § USC 102(e) be withdrawn.

Claim Rejections - 35 USC § 103

The Office Action rejected claims 16, 31, 38 and 39 under 35 USC § 103(a) as being unpatentable over Cardot (USP 6,831,761). Claims 16, 31, 38, and 39 have been canceled. Claim 1 has been amended to incorporate the limitations of claim 16 and selected limitations from intervening claims. Claim 18 has been amended to incorporate the limitations of claim 31 and selected limitations of intervening claims. Claim 33 has been amended to incorporate the limitations of claim 38 and selected limitations of intervening claims. Claims 1, 18, and 33 have been reworded for clarity. Amended claims 1, 18 and 33 are supported by the specification at paragraphs 0185-0192. The rejection of claims 16, 31, and 38 under 35 USC § 103(a) will be considered as if applied to amended claims 1, 18, and 33.

In the rejection of claims 16, 31, and 38, the Office Action acknowledges that Cardot does not disclose improving gradation of the color image signals. The Office Action asserts, "It would have been obvious to one of ordinary skill in the art to also improve gradation in order to improve the overall quality of the generated image." In the reply to arguments previously submitted by Applicant's agent, the Office Action goes on to state, "Examiner merely asserts that it would have been obvious to want to also improve gradation in forming a high-resolution image. Therefore the rejection is proper."

The rejection is traversed with respect to claims 1, 18, and 33 on the grounds that it fails to meet the requirements for a *prima facie* case of obviousness. Specifically, the reference fails to teach all limitations of the claims and the Examiner has failed to provide a sustainable line of reasoning why the claims are obvious over the insufficient teachings of the reference.

MPEP 706.02(j) states the requirements for a *prima facie* case of obviousness as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
>
> To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

MPEP 2143.03 expands upon the requirements for a prima facie case of obviousness:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Office Action "recognizes that Cardot is silent regarding improving gradation", and thus does not teach or suggest the "first, second, and third enhanced color images signals having improved gradation..." as recited in claims 1, 16, and 33. In addition Cardot does not teach or suggest that "the monochrome output signal has higher gradation than the first, second, and third color output signals", also as recited in claims 1, 16, and 33.

The Examiner's assertion that "it would have been obvious to want to also improve gradation in forming a high resolution image" is arguable and moot since claims 1, 18, and 33 do not contain limitations relating to forming a higher resolution image. The Examiner's assertion certainly does not overcome Cardot's deficiency in describing all limitations of the claims. Thus it is respectfully submitted that independent claims 1, 18, and 33 and depending claims 42-52 are allowable.

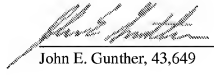
Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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